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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/711,578      | 11/13/2000  | Nora Femenia         | BRENDA 8            | 7170             |

21186 7590 07/15/2005

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| EXAMINER |
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ELISCA, PIERRE E

|          |              |
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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/711,578

Applicant(s)

FEMENIA ET AL.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.  
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 1-8, 10-18 and 20 is/are allowed.  
 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
 7) ☒ Claim(s) 9 and 19 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to Applicant's response, filed on 05/11/2005.
2. Claims 1-20 are pending.

### ***Allowable Subject Matter***

3. Claims 9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The rejection to claims 1-8, 10-18 and 20 under 35 U.S.C. 103 (a) as being unpatentable over Tavor et al U.S. Pat. No. 6,553,347 in view of D'Alessandro U.S. Pat. No. 6,556,974 as set forth in the office action mailed on 01/07/2005 is maintained.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-8, 10-18 and 20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Tavor et al. (U.S. Pat. No. 6,553,347) in view of D'Alessandro (U.S. Pat. 6,556,974).**

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As per claims 1, 2, 5, 6, 10-12, 15 and 20 Tavor substantially discloses a method for conducting one to one commercial negotiations (negotiation or managing a dispute) through an electronic medium such as the Internet, comprising:

automatically receiving information relating to the dispute from one of an initiator and a respondent, the initiator and the respondent being parties to the agreement (initiator and a respondent or user and vendor) see., abstract, col 4, lines 20-41, specifically wherein it is stated that the negotiation process features one or more exchanges between the user and the system, including discounts given by the system and responses to the price offers of the user. The limitation "the initiator and the respondent being parties to the agreement" is also disclosed by Tavor in col 12, lines 13-28); and

iteratively providing portions of the information to the other of the initiator and the respondent in accordance with predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator or the respondent, or relating to the number of portions of the information to be provided at an iteration (see., abstract, col 4, lines 20-41, specifically wherein it is stated that the system offers the product for a specific price, a price that may be optionally decreased as negotiation continues, please note that the specific price is interpreted as the portion of the information.

Travor fails to explicitly disclose the step of "predetermining criteria". However, D'Alessandro discloses a method for evaluating current business performance. A predetermined set of performance criteria are measured by the use of an automated employee and non-employee interview system (see., abstract, col 3, lines 1-21).

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As per the predetermined type of criteria being claimed, the Examiner submits that no patentable differences exist since a plurality types of predetermined criteria may exist. Thus, the type of predetermined criteria does not affect the functioning of the system of Tavor since data is data in computer manipulation. Incorporating such types of criteria in the system of Tavor would have been obvious to one of ordinary skill in the art at the time of the invention in order to evaluate and forecast of the business entity's performance.

As per claims 3, 13, and 16 Tavor discloses the claimed method wherein the received information includes at least one factor and an evaluation of the desirability or cost of the factor (see., 2, lines 56-61).

As per claims 4, and 14 Tavor discloses the claimed method wherein the at least one factor includes at least two of historical harm, future harm, an incentive, a punishment, a request, an offer, and a desired outcome (see., col 2, lines 31-41, lines 56-61).

As per claims 7, 8 and 17-18 Tavor discloses the claimed method of automatically proposing an agreement to resolve the dispute (or negotiation) based on the received information (see., col 12, lines 13-28).

**RESPONSE TO ARGUMENTS**

7. Applicant's arguments filed on 05/11/2005 have been fully considered but they are not persuasive.

In response to Applicant's arguments, Applicant argues that the prior art of record (Tavor and D'Alessandro) fail to disclose the recited feature:

a. "managing or resolving a dispute regarding a preexisting agreement". Based upon the foregoing rejection detailed above, it is believed that Tavor discloses this assertion in the abstract, col 4, lines 20-41, specifically wherein it is stated that the negotiation process features one or more exchanges between the user and the system, including discounts given by the system and responses to the price offers of the user. The limitation "the initiator and the respondent being parties to the agreement" is also disclosed by Tavor in col 12, lines 13-28. Response to the price of the user is interpreted as a step of resolving a price dispute.

b. "receiving information from parties to a dispute regarding a pre-existing agreement". As stated above, Tavor discloses this limitation in the abstract, col 4, lines 20-41, specifically wherein it is stated that the negotiation process features one or more exchanges between the user and the system, including discounts given by the system and responses to the price offers of the user. The limitation "the initiator and the respondent being parties to the agreement" is also disclosed by Tavor in col 12, lines 13-28.

c. "consider iteratively providing portions of information ....". However, the Examiner respectfully disagrees since Tavor discloses this limitation in the abstract, col 4, lines

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20-41, specifically wherein it is stated that the system offers the product for a specific price, a price that may be optionally decreased as negotiation continues, please note that the specific price is interpreted as the portion of the information.

d. Applicant also argues that D'Alessandro fails to disclose " a predetermined criteria". However, D'Alessandro discloses a method for evaluating current business performance. A predetermined set of performance criteria are measured by the use of an automated employee and non-employee interview system (see., abstract, col 3, lines 1-21).

As per the predetermined type of criteria being claimed, the Examiner submits that no patentable differences exist since a plurality types of predetermined criteria may exist. Thus, the type of predetermined criteria does not affect the functioning of the system of Tavor since data is data in computer manipulation. Incorporating such types of criteria in the system of Tavor would have been obvious to one of ordinary skill in the art at the time of the invention in order to evaluate and forecast of the business entity's performance.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Pierre Eddy Elisca

**Primary Patent Examiner**

**July 12, 2005**